

Interview Summary

Application No.

10/813,506

Applicant(s)

SHOEMAKER ET AL.

Examiner

Mark Staples

Art Unit

1637

All participants (applicant, applicant's representative, PTO personnel):

(1) Mark Staples.(3) Andrea Antler.(2) Kenneth Horlick.(4) Maya Elbert(5) Ellen Sun.Ellen Sun
corrected 05/08/2009 /M.S./

Date of Interview: 29 January 2009.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____.

Claim(s) discussed: 122.

Identification of prior art discussed: Lockhart et al. (1997), Bowtell (1999), and Hui et al. (filed 1996).

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

/Mark Staples/
Examiner, Art Unit 1637, 01/29/2009

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Applicant first presented that the claimed array, which is a product, has three key limitations: (1) a large span of 25,000 bp, (2) a high density where distance between sequential sites is always less than 500 bp, (3) at least two probes with sequences entirely within an intron. Applicant argued that while Lockhart et al. and Bowtell respectively teach arrays with a large span and high density that neither teaches probe sequences entirely within an intron. Applicant thus argued that one of skill in the art at the time of the claimed invention would not have reason to combine the teachings of Lockhart et al. and Bowtell with the teachings of Hui et al. And while Hui et al. teach oligonucleotides from intron regions of the genomic VHL tumor suppressor gene, Applicant argued that one of skill in the art would not have had a reason to combine this teaching of Hui et al. and have the oligonucleotides as taught by Hui et al. on an array of large span and high density.

In considering a response to the last Office action, Applicant was advised that an argument that a specific teaching, suggestion, or motivation is required to support an obviousness rejection over prior art is foreclosed by the *KSR* decision [*KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007)(Kennedy, J.)]. Applicant agreed and argued that there was no common sense reason that someone of skill in the art at the time of the claimed invention would have combined the teachings of the references.